

Ser. No. 09/578,474  
YOR919990486US1

14

### **REMARKS**

An Excess Claim Fee Payment Letter is submitted herewith to cover the cost of two (2) excess total claims.

Claims 1-28 and 33-52 are all the claims presently pending in the application. Claims 1, 2, 34-39 and 41 have been amended to more particularly define the claimed invention. Claims 51-52 have been added to claim additional features of the claimed invention.

It is noted that the claims have been amended solely to more particularly point out Applicant's invention for the Examiner, and not for distinguishing over the prior art, narrowing the claim in view of the prior art, or for statutory requirements directed to patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Applicant gratefully acknowledges that claims 24-28 and 33 are allowed and claims 6-13 would be allowable if rewritten in independent form. However, Applicant respectfully submits that all of the claims are allowable.

Claims 1-5, 14-18, 19-23 and 34-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muto Akihiro (JP 10-074221) (hereinafter "Muto") in view of Ohta et al (U.S. Patent No. 5,991,623). Claims 41, 42 and 44-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muto in view of Henley (U. S. Patent Publication No. 2002/0065758) further in view of Ohta. Claims 1-5, 14-23 and 34-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okumura et al. (JP 10-021302) in view of Ensor et al (U.S. Patent No. 5,721,780).

These rejections are respectfully traversed in view of the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (e.g., as recited in claim 1) is directed to a method of conducting business electronically between a first party and a second party. The method includes providing an intermediary relationship with a third party who knows an identity of the first party but no privacy-compromising information regarding a proposed electronic business transaction between the first and second parties, conducting the electronic business transaction between the first and second parties through the third party by using a document, and replacing, by the third party, identification data of the first party in the document with an identifier, and transmitting the

Ser. No. 09/578,474  
YOR919990486US1

15

document including the identifier to the second party, such that the identity of the first party is kept from the second party (Application at page 8, line 15-page 9, line 3; Figure 3). Further, the second party is provided with information identifying the first party as a transactional party in the electronic business transaction.

In conventional methods of conducting electronic business, a customer (e.g., first party) may complete a form (e.g., an electronic version of an insurance application form) with the customer's identification data (e.g., name, data of birth, medical information, etc.) and forward the completed application to a service provider (e.g., second party). However, the development of information technology (IT) such as data mining, has allowed businesses to use data such as the customer's identification data to acquire more information regarding the customer than customer would prefer to disclose (Application at page 2, line 5-page 3, line 6).

The claimed invention, on the other hand, provides a method of conducting business electronically between two parties which includes replacing, by the third party, identification data of the first party in the document with an identifier, and transmitting the document including the identifier to the second party, such that the identity of the first party is kept from the second party (Application at page 8, line 15-page 9, line 3; Figure 3). This may allow the transaction to be conducted without the second party ever learning the identity of the first party.

## **II. THE EXAMINER HAS FAILED TO RESPOND TO APPLICANT'S TRAVERSAL ARGUMENTS**

Applicant would remind the Examiner is required to answer all of the material traversed by Applicant. Indeed, Applicant would point out that MPEP §707.07(f) provides that "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, **take note of the applicant's argument and answer the substance of it**" (emphasis added).

Here, the Examiner has clearly failed to answer all of the material traversed by Applicant. For example, in the Amendment filed on October 5, 2005, Applicant pointed out Ensor is completely unrelated to replacing identification data in a document. In fact, the Examiner attempted to rely on col. 6, lines 26-45 in Ensor to support his allegations but Applicant pointed out that nowhere in this passage or anywhere else, does Ensor teach or suggest replacing (e.g., by the third party) first party identification data in a document with an identifier. Indeed, nowhere does this passage even disclose a "document" (e.g., an insurance application that is completed by

Ser. No. 09/578,474  
YOR919990486US1

16

a customer) as in the claimed invention. Indeed, the "password" being changed is only "stored within the memory 126" and is not contained in any document.

Applicant also pointed out that the passage does not even disclose "identification data" (e.g., name, address, medical history, etc.). Instead, Ensor merely discloses changing a password with another password.

Nowhere has the Examiner even attempted to reply to this argument of Application. Therefore, the Office Action is clearly incomplete that the Examiner must mail to Applicant a new non-final Office Action which responds to all of Applicant's arguments.

### III. THE ALLEGED PRIOR ART REFERENCES

#### A. Muto and Ohta

The Examiner alleges that Muto would have been combined with Ohta to form the invention of claims 1-5, 14-18, 19-23 and 34-46. Applicant respectfully submits, however, that these references would not have been combined as alleged by the Examiner and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Muto discloses an information mediating device 2 applied to a network system, which is intended to protect a user's privacy. The device includes a data interpreting part 12B for receiving information transmitted from equipment 1, and a data converting part 12A for converting the originating source address of the equipment 1 into the address of the device 2.

Ohta discloses a wireless communication system which is intended to prevent unjust use of a personal communication terminal.

Applicant respectfully submits that these references are completely unrelated and would not have been combined as alleged by the Examiner. Thus, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that there is no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Ser. No. 09/578,474  
YOR919990486US1

17

Moreover, neither Muto, nor Ohta, nor any alleged combination thereof teaches or suggests *"replacing, by said third party, identification data of said first party in said document with an identifier, and transmitting said document including said identifier to said second party, such that said identity of said first party is kept from the second party"*, as recited, for example, in claim 1 and similarly recited in claims 2, 24, 34-39 and 41). As noted above, this may allow the transaction to be conducted without the second party ever learning the identity of the first party.

For example, as illustrated in Figure 3, when the third party 120 receives the application A from a first party 100, the third party 120 may cut off the header H 210 and replace it with a number, before sending the application A to the second party 110 (Application at page 19, lines 5-8). Thus, the second party 110 may receive the application A with an identifier in place of the identification data.

Clearly, this is not taught or suggested by the cited references. Indeed, the Examiner expressly concedes on page 4 of the Office Action that this feature is not taught or suggested by Muto, but alleges that the feature is disclosed by Ohta. The Examiner is clearly incorrect.

First, Applicant would point out that Ohta is completely unrelated to the claimed invention. Indeed, as noted above, **Ohta is directed to a wireless communication system**, which is not necessarily related to a method of conducting electronic business.

Further, Applicant would point out that the claimed invention involves replacing (e.g., by the third party) first party identification data in a document with an identifier, and transmitting the document (e.g., transmitting, by the third party, the document with the identification data replaced by the identifier) to the second party. **Ohta, on the other hand, is completely unrelated to replacing identification data in a document.**

Indeed, the Examiner attempts to rely on col. 11, lines 35-55 and col. 12, lines 1-27 to support his allegations. Specifically, the Examiner alleges that "[a] user of a contracted terminal transmits a special number for replacing the communication control information and a password by a cryptographic key". However, nowhere in this passage or anywhere else, does Ohta teach or suggest replacing (e.g., by the third party) first party identification data in a document with an identifier.

In fact, nowhere in this portion of Ohta on which the Examiner relies, or anywhere else, does Ohta even teach or suggest a document. Indeed, even assuming that a message may be

Ser. No. 09/578,474  
YOR919990486US1

18

transmitted by the personal communication terminal 11<sub>11</sub>, this message certainly cannot be reasonably equated with a document. Certainly, such a mere message cannot be reasonably equated with a document which is used to conduct an electronic business transaction between the first and second parties.

Further, nowhere does Ohta even teach or suggest an electronic business transaction between first and second parties. That is, even assuming that the personal communication terminal 11<sub>11</sub> is a party and the exchange 31 is another party, nowhere does Ohta teach or suggest that there is any electronic business transaction between the terminal 11<sub>11</sub> and the exchange 31. In fact, nowhere does Ohta teach or suggest a third party, but discloses only the terminal 11<sub>11</sub> and the exchange 31 (e.g., see Ohta at Figure 9).

Therefore, Ohta certainly does not teach or suggest replacing, by the third party, identification data of the first party in the document with an identifier, and transmitting the document including the identifier to the second party, such that the identity of the first party is kept from the second party. Therefore, Ohta certainly does not make up for the deficiencies of Muto.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### **B. Henley**

The Examiner alleges that Muto would have been combined with Henley and Ohta to form the invention of claims 41, 42, and 44-46. Applicant respectfully submits, however, that these references would not have been combined as alleged by the Examiner and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Henley discloses a method and system for provision and acquisition of medical services and products.

However, Applicant respectfully submits that Henley is unrelated to Muto and Ohta and would not have been combined as alleged by the Examiner. Thus, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Ser. No. 09/578,474  
YOR919990486US1

19

Further, Applicant submits that there is no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Muto, nor Henley, nor Ohta, nor any alleged combination thereof teaches or suggests "*replacing, by said third party, identification data of said first party in said document with an identifier, and transmitting said document including said identifier to said second party, such that said identity of said first party is kept from the second party*", as recited, for example, in claim 1 and similarly recited in claims 2, 24, 34-39 and 41).

Clearly, this is not taught or suggested by Henley. Indeed, Henley may disclose a Bidding Form Page in Figures 17A, 17B that may be transmitted from a patient/bidder (Henley at [0128]). However, it is completely unreasonable to attempt to equate this "page" with the document in the claimed invention.

Indeed, Applicant would point out that nowhere does Henley teach or suggest a third party, let alone replacing (e.g., by the third party) first party identification data in the Bidding Form page with an identifier.

Therefore, Henley certainly does not teach or suggest replacing, **by the third party**, identification data of the first party **in a document** with an identifier, and transmitting the **document including the identifier** to the second party, such that the identity of the first party is kept from the second party. Therefore, Henley certainly does not make up for the deficiencies of Muto and Ohta.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

### C. Okumura and Ensor

The Examiner alleges that Okumura would have been combined with Ensor to form the invention of claims 1-5, 14-23 and 34-46. Applicant submits, however, that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Ser. No. 09/578,474  
YOR919990486US1

20

Applicant respectfully submits that these references are completely unrelated and would not have been combined as alleged by the Examiner. Indeed, Okumura is directed to a system which allegedly enables a service provider to acquire information such as age, income, carrier, etc. stored in a third person while guaranteeing anonymity of a user (Okumura at Abstract), whereas Ensor is directed to a method of determining whether access to a network is authorized (Ensor at col. 7, lines 2-4). Thus, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that there is no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Okumura, nor Ensor, nor any alleged combination thereof teaches or suggests *"replacing, by said third party, identification data of said first party in said document with an identifier, and transmitting said document including said identifier to said second party, such that said identity of said first party is kept from the second party"*, as recited, for example, in claim 1 and similarly recited in claims 2, 24, 34-39 and 41).

Clearly, this is not taught or suggested by the cited references. Indeed, the Examiner expressly concedes that this feature is not taught or suggested by Okumura, but alleges that the feature is disclosed by Ensor. The Examiner is clearly incorrect.

First, Applicant would again point out that Ensor is completely unrelated to the claimed invention. Indeed, as noted above, Ensor is directed to a method of determining whether access to a network is authorized, which is not necessarily related to a method of conducting electronic business.

Further, Applicant would again point out that the claimed invention involves replacing by the third party first party identification data in a document with an identifier, and transmitting the document (e.g., by the third party) with the identification data replaced by the identifier to the second party. Ensor, on the other hand, is completely unrelated to replacing identification data in a document.

Indeed, the Examiner attempts to rely on col. 6, lines 26-45 in Ensor to support his allegations. However, nowhere in this passage or anywhere else, does Ensor teach or suggest

Ser. No. 09/578,474  
YOR919990486US1

21

replacing (e.g., by the third party) first party identification data in a document with an identifier. In fact, this passage in Ensor merely discloses a process in a network control center 108, 206 for automatically changing the passwords stored within the memory 126 of the user terminals 110, 202, and updating the corresponding list of passwords stored in the control center's internal database 112 (Ensor at col. 6, lines 26-34).

First, nowhere does this passage even disclose a "document" (e.g., an insurance application that is completed by a customer) as in the claimed invention. Indeed, the "password" being changed is only "stored within the memory 126" and is not contained in any document.

Second, the passage does not even disclose "identification data" (e.g., name, address, medical history, etc.). Instead, Ensor merely discloses changing a password with another password.

Applicant would again point out that the second passwords is no less revealing of a user's identity than the first password. That is, Ensor does not replace a password with an identifier which may be used, for example, to prevent a second party from learning of the first parties identity. That is, the function of the second password is completely unrelated to the function of the "identifier" in the claimed invention. Indeed, Ensor does not even contemplate this underlying concept of the claimed invention.

Therefore, Ensor certainly does not teach or suggest replacing by the third party first party identification data in a document with an identifier, and transmitting the document with the identification data replaced by the identifier to the second party.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-28 and 33-52, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.



Ser. No. 09/578,474  
YOR919990486US1

22

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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1/31/06

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing was filed by facsimile with the United States Patent and Trademark Office, Examiner Pierre Elisca, Group Art Unit # 3621 at fax number (571) 273-8300 this 31st day of January, 2006.



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